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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/936,922	10/31/2001	Meir Shinitzky	110598	3023

7590 07/28/2004

BROWDY AND NEIMARK
624 NINTH STREET, N.W.
WASHINGTON, DC 20001

EXAMINER

WANG, SHENGJUN

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 07/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/936,922

Applicant(s)

SHINITZKY, MEIR

Examiner

Shengjun Wang

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 17-26 and 37 is/are pending in the application.
- 4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☒ Claim(s) 1-5, 8, 17, 18, 26 and 37(all in part), and 7, 22, 23 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Continuation of Disposition of Claims: Claims withdrawn from consideration are 1-5, 8,17,18,26,37 (all in part) and 6,19-21,24, 25.

DETAILED ACTION

1. Claims 1-5, 8, 17, 18, 26, 37 (all in part) and 6, 19-21, 24, 25 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on May 6, 2004.

2. Applicant's election with traverse of invention group II, which read on claims 1-5, 7, 8, 17, 18, 22, 23, 26 and 37 in the reply filed on May 6, 2004 is acknowledged. The traversal is on the ground(s) that No rejection has been imposed, and all claim should be allowable. This is not found persuasive because the previous examination was limited to the elected species. The restrictions among the full scope of claimed invention are proper for reasons discussed in the restriction requirements. AS stated in the prior office action, the different inventions have different issues regarding patentability and enablement and represent patentable distinct subject matter, and lack a common core technical feature. Particularly, the claimed inventions essentially encompass any therapeutical utilities of the recited compounds, and reach through for treatments of any diseases might be treatable by the recited compounds. A variety issues may arise, such as enablement, written description, and inherency. Note newly recognized functions of an old method, or composition, would not make the old method or composition patentable.

The requirement is still deemed proper and is therefore made FINAL.

The claims have been examined insofar as they read on elected invention.

Claim Objections

3. Claims 1-5,7, 8, 17, 18, 22, 23, 26 and 37 are objected to as being encompassing subject matter directed to nonelected invention, or being dependent of such claims, but would be allowable if rewritten in independent form including all of the limitations of elected invention, i.e., administering the compounds herein to a subject having neurodegenerative disorders.

Reasons for Allowance

4. The claimed invention is not obvious over the cited prior arts because the six-membered ring compounds herein are not obvious over the five membered rings disclosed in the prior art for reasons set forth on the record. Further, it is noted that Ashani et al. (US 4,472,320) disclose a method of using a six-membered phosphate compound, encompassed by the general formula herein, for treating cholinergic diseases. However, there is no teaching or suggestion that any compound useful for treating cholinergic diseases would be surely useful for treating neurodegenerative disorders.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shengjun Wang, Ph.D. whose telephone number is (571) 272-0632. The examiner can normally be reached on Monday-Friday from 8:30 to 5:00.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, can be reached on (571) 272-0629. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9302.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.

 SHENGJUN WANG
PRIMARY EXAMINER

Shengjun Wang

July 21, 2004